



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/804,081

Confirmation No.: 9115

In re Application of:

Fumihiko ARAKAWA et al.

Group Art Unit: 2872

Filed: March 13, 2001

Examiner: Alessandro V. Amari

For: ANTIREFLECTION FILM

COMMENTS AND REPLY TO ADVISORY ACTION

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner had remarked in the Advisory Action mailed November 2, 2004 that the rejection of the claims was being maintained because no evidence had been offered why the concave/convex portions of Clapham et al. '465 cannot be combined or would destroy the antireflection film of Oka et al. '524.

Applicants respectfully submit that a consideration of the primary and secondary references, without relying upon the instant claims to justify the combination, would not result in a conclusion to combine those teachings by a person of ordinary skill in the art. It is not a matter of how the references could be combined;

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it is more properly a matter of why the references should be combined. See In re Gordon, 221 USPQ 1125 (Fed. Cir 1984). The court observed, "The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (citations omitted.)" 221 USPQ at 1127. The cited art does not suggest the combination asserted by the Examiner.

Applicants did not suggest in their last reply that combining the references would destroy the antireflection film of the primary reference. Applicants explain both in the Amendment Under 37 CFR 1.116 filed November 18, 2003 and in the Request for Reconsideration filed August 10, 2004 that one of ordinary skill in the art would have no proper reason (no motivation) to combine the teachings of the references. The disclosure in Clapham et al. '456 at column 1, lines 52 to 53 of "a reduced reflectance to electromagnetic radiation in the visible waveband" does not teach or suggest the controls on the pitch of the fine concaves and convexes in the manner of the present claims. Claim 1 of Clapham et al. '465 shows the purpose of the control, namely "to convert the effect of said light pattern on said photosensitive layer into

a regular array of protuberances on said surface having a height which is not less than one third of the length of the longest wavelength in the band and at a spacing between adjacent protuberances which is less than the length of the shortest wavelength of the band divided by the refractive index of the material of which the protuberances consist." A person reading such disclosure would not use it as a basis for suggesting that one should modify the Oka et al. '524 device to include fine concaves and convexes of a specific continuous and regular shape that are at a predetermined pitch of not greater than the wavelength of light.

Oka et al. '524 refers to a layer having "a fine uneven surface" but there is no discussion in the patent of the relationship of that "fine uneven surface" to what is claimed here, namely "the concave-convex portion having a specific continuous and regular shape comprising fine concaves and convexes continuously provided at a predetermined pitch of not more than the wavelength of light." No such limitation or property is described in Clapham et al. '465 and there is no proper reason to combine the references.

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Applicants lastly reiterate that the primary reference distinguishes between an antireflection-antiglare film and an antireflection film and that the "fine uneven surface" is shown in the patent to be used on an antiglare layer and not for an antireflection film; see the arguments in the first paragraph on page 3 of the Request for Reconsideration filed August 10, 2004.

Applicants respectfully submit that claims 1, 2, 5 to 7, and 12 patentably define over the art.

The Examiner is requested to telephone the undersigned if anything further is required prior to allowance.

Respectfully submitted,

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